

DOCKET NO.: 241891US0CONT/ds

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:

GROUP: 1612

Jean-Thierry SIMONNET, et al.

SERIAL NO: 10/724,826

EXAMINER: MAEWALL, SNIGDHA

FILED: December 2, 2003

FOR: NANOEMULSION BASED ON SUGAR FATTY ESTERS OR ON SUGAR
FATTY ETHERS AND ITS USES IN THE COSMETICS,
DERMATOLOGICAL AND/OR OPHTHALMOLOGICAL FIELDS

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

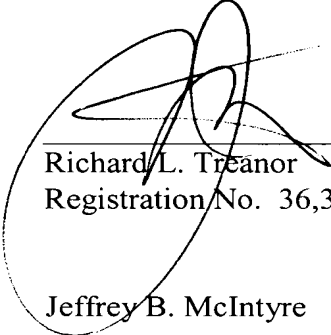
This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s). No more than five (5) pages are provided.

I am the attorney or agent of record.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,
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ATTACHMENT IN SUPPORT OF REQUEST FOR PRE-APPEAL REVIEW

COMMISSIONER FOR PATENTS
ALEXANDRIA, VA 22313

SIR:

The Examiner rejected the pending claims under 35 U.S.C. § 103 as obvious over U.S. patent 5,753,241 (“Ribier I”) in view of U.S. patent 5,130,122 (“Tabibi”) and J. Colloid & Interface Science (“Kenji”) as evidenced by U.S. patent 6,669,849 (“Nguyen”). In making this rejection, the Examiner interpreted the claims to require the presence of a “surfactant which is solid at or less than 45 degree Celsius and there is no recitation of specific surfactants. The claims as recited read on any surfactant which has melting point less than 45 degrees Celsius.”

The Examiner’s claim interpretation is clearly wrong. The pending claims require the presence of a specific type of sugar surfactant which is solid at 45°C (or at lesser temperatures such as room temperature (25°C)). Thus, the claims are directed to solid sugar surfactants at the identified temperatures, not to any type of surfactant which has a melting point at the identified temperatures. Given that the Examiner’s claim interpretation is

incorrect, it follows that the Examiner's rejection based on this faulty interpretation must also be incorrect.

The Examiner's error is critical. As demonstrated in the Rule 132 declaration submitted in December 2008, adding the required solid sugar surfactant to a nanoemulsion having at least one oil having a molecular weight of greater than 400 results in improved compositions (as compared to adding a similar, non-claimed surfactant which is not solid to a composition). Thus, ignoring the claim requirement that the surfactant is a solid sugar surfactant ignores a critical claim limitation and skews that entire analysis.

None of the applied art, alone or in combination, teaches or suggests adding the required solid surfactants to nanoemulsions having at least one oil having a molecular weight of greater than 400. Ribier I is the only reference relating to nanoemulsions, it but does not disclose the required solid sugar surfactants. The remaining references do not disclose nanoemulsions: Kenji and Tabibi relate to microemulsions;¹ and Nguyen relates to a completely different art, disclosing a water treatment process.

No teaching or suggestion exists in any of the applied art to modify the disclosure therein to combine the required solid sugar surfactant and the required oil having the required molecular weight (greater than 400) while at the same time lowering oil globule size to that of the claimed nanoemulsion with the reasonable expectation that a stable nanoemulsion product would result.

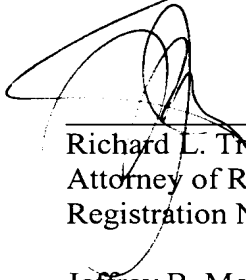
¹ Specifically, Tabibi discloses emulsions with oil globules having a diameter of 0.5 microns (500 nm), preferably 0.3 microns (300 nm), and exemplifies emulsions with oil globules having a diameter of 0.17 microns (170 nm), 0.20 microns (200 nm), and 0.27 microns (270 nm). Thus, Tabibi does not disclose or suggest preparing the claimed nanoemulsions having the required oil globule size.

Application No. 10/724,826
Response to Office Action dated March 16, 2009

For all of the above reasons, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 103.

Respectfully submitted,

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